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Dated: 5/16/06

Signature: [Signature]

(Susan Lanney)

Docket No.: ESCL-P01-124
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Clarke *et al.*

Confirmation No.: 9050

Application No.: 10/629,933

Art Unit: 1651

Filed: July 29, 2003

For: MULTI-STEP METHOD FOR THE
DIFFERENTIATION OF INSULIN POSITIVE,
GLUCOSE RESPONSIVE CELLS

Examiner: L. B. Lankford

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This reply is being filed in response to the outstanding Restriction Requirement, mailed on March 21, 2006, in connection with the above application. Applicants respectfully request a ONE-month extension of time to respond to the outstanding Restriction Requirement. A Petition for Extension of Time and the appropriate fee are being filed concurrently.

Applicants hereby elect Group I, Claims 1-47, *with traverse*, on the following grounds.

Applicants traverse this restriction requirement on the basis that Groups I and II-V are so closely related and they share common technical features that would facilitate searching all groups at once. Therefore, a search and examination of all pending claims can be made without imposing additional serious burden on the Examiner. Accordingly, reconsideration and withdrawal of the Restriction Requirement are respectfully requested.

Regarding species election, Applicants hereby provisionally elect, *for search purpose only*, the following Species *with traverse*.

Species 1 (source of Insulin⁺ cells): adult stem cells derived from adult pancreatic tissue. Presently, Claims 1-47 read on the elected species.

Species 2 (specific gp130 agonist present in the culture during selection): cardiotrophin-1. Presently, Claims 1-47 read on the elected species.

Species 3 (specific mitogen / combination in culture during the dissociation of the spheres): FGF-18. Presently, Claims 1-47 read on the elected species.

Species 4 (specific growth factors or agonists present in the culture during the culture of the spheres): EGF, FGF-18, IGF-I, IGF-II, TGF- α , VEGF, sonic hedgehog, and heparin. Presently, Claims 1-47 read on the elected species.

Species 5 (material of substratum on which the spheres are plated): superfibronectin. Presently, Claims 1-47 read on the elected species.

Species 6 (additional factor included in the high-glucose media present during the plating of the spheres): serum, PYY, HGF, and forskolin. Presently, Claims 1-47 read on the elected species.

Applicants note that at least independent claims 1, 15, and 41 are generic claims linking elected and non-elected species. Pursuant to MPEP 809.04, “[i]f a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the non-elected inventions that are linked to the elected invention by such allowed linking claim.” Thus, restrictions imposed on species encompassed by generic claims must be withdrawn upon indication of an allowable generic claim (MPEP 809). In other words, upon the allowance of a generic claim, Applicants are entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141 (MPEP 809.02(a)).

Also as to species election requirement, Applicants submit that most species subjected to election are encompassed by Markush groups. Pursuant to MPEP 803.02, “If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions.” Thus Applicants respectfully point out that the search of the Markush-type claim

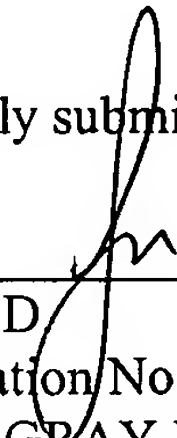
will be extended to non-elected species should no prior art be found that anticipates or renders obvious the elected species (MPEP 803.02).

Applicants note that the Examiner essentially acknowledged Applicants' position above on page 9, first full paragraph of the Restriction Requirement, especially the fact that the species elections above are *for search purposes only*.

Applicants believe that no fee in addition to the one-month extension fee is due with this response. However, if any other fee is due, please charge our Deposit Account No. **18-1945**, under Order No. **ESCL-P01-124** from which the undersigned is authorized to draw.

Dated: May 16, 2006

Respectfully submitted,

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